



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ulrich KLAR et al.

Confirm. No.: 5068

Serial No.: 09/913,163

Examiner: CHANG, Celia C.

Filed: December 7, 2001

Group Art Unit: 1625

Title: EPOTHILON DERIVATIVES, METHOD FOR THE PRODUCTION AND THE USE THEREOF AS PHARMACEUTICALS

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notice to File Corrected Application Papers dated October 28, 2005, attached are:

- 1) a substitute specification (clean copy),
- 2) a substitute specification (marked up copy), and
- 3) an abstract on a separate sheet.

Applicants noticed that some of the chemical structures in the application were printed somewhat faintly in addition to the ones pointed out in the Notice. These somewhat faint chemical structures are made darker. Applicants believe no new matter has been added.

On page 41, in the chemical structure labeled "I," the bonds are faint, but clearly present. Additionally, also from the location of the substituents, the position of the bonds to them is easily determinable. Additionally, the bond to the substituent "O" is a double bond, which is clearly determinable by one of ordinary skill in the art.

On page 41, in the chemical structure labeled "II," part of the phenyl ring is hard to make out. However, enough of the structure is clear that one can easily determine that a phenyl ring is there. A bond that is not part of the oxazole ring from the carbon atom labeled 4 is faint, but clearly there.

On page 42, in the chemical structure labeled “III,” there are some faint bonds, but all are clearly there. Additionally, the location of the substituents also clearly reaffirms the presence of the bonds.

On page 42, in the chemical structure labeled “IV,” there are some faint bonds, but most are clearly there and their presence is further reaffirmed by the substituents to which they are connected. One bond appears ambiguous on first impression in this formula, but in context, when reading in the specification that this compound is a reaction product of the compounds represented by chemical structures II and III, it becomes apparent that there is a bond that is not part of the oxazole ring from the carbon atom corresponding to the carbon atom labeled 4 in the compound of formula II.

On pages 46, in several chemical structures, there are some faint bonds, but all are clearly there. Additionally, the location of the substituents also clearly reaffirms the presence of these bonds.

On pages 47, in several chemical structures, there are some faint bonds and a few that may be on first impression ambiguous. The location of the substituents however clearly reaffirms the presence and location of these bonds.

Applicants also noticed that two reaction schemes in the specification were incorrectly labeled as figures, i.e., designated as Figs. 1 and 2. These are more appropriately named reaction schemes, which are properly embeddable into the specification. Thus, the terms “Figs. 1 and 2,” “Fig. 1” and “Fig. 2” on pages 45, 46 and 47, were amended to “reaction schemes α and β ,” “Reaction scheme α :” and “Reaction scheme β :” in the order recited.

Furthermore, the specification also identified other reaction schemes as “diagram[s].” In order to clarify the specification, the terms “diagram” on each of pages 21, 22, 28, 30, 35, 50, 56, 58, 62, 75, 76, 77, 79 and 80 were amended to “reaction scheme” also.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: SCH-1814

Date: November 7, 2005

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



Serial Number
09913163

Date Mailed
10/28/05

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Notice of Allowance Mailed

This application has been accorded an Allowance Date and is being prepared for issuance. The application, however, is incomplete for the reasons below.

Applicant is given 30 days from the mail date of this Notice within which to correct the informalities indicated below. A failure to reply will result in the application being ABANDONED. This period for reply is NOT extendable under 37 CFR 1.136 (a) or (b).

- Specification---pages 41 and 42 contain illegible formulas.

APPLICANT MUST SUPPLY MISSING INFORMATION WITHIN 30 DAYS OF THE MAIL DATE OF THIS NOTICE.

A copy of this notice MUST be returned with the reply. Please address response to Commissioner for Patents P.O. Box 1450
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